



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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364B
ITW

Appellant: Carl E. Whitcomb

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Serial No.: 10/075096

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Examiner: Son T. Nguyen

Filed: October 29, 2001

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Group Art Unit: 3643

For: Root Growth Barrier

§ 8

CERTIFICATE OF MAILING

37 C.F.R. 1.8

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REPLY BRIEF OF APPELLANT

Attorney for Appellant
Frank J. Campigotto
Registration No. 48,130
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
713-939-9444

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Appellant hereby files this Reply Brief in response to the Examiner's Answer mailed July 1, 2004 and having a two month period for reply set to expire on September 1, 2004. Appellant timely filed a Notice of Appeal to this Board on April 5, 2004, appealing the decision of the Examiner in the Final Office Action dated January 14, 2004, for the above captioned application. Applicant timely filed its Appeal Brief on April 16, 2004.

ISSUES AND ANALYSIS

(a) Whether claims 1, 2, 4, 13-16, 18, 19, 29, 30, 41, 46, 48, 49, 53 and 63 should stand rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent Application No. 2, 073, 576A of Berlit, *et al.*

1. Berlit does not set forth each and every limitation claimed by Applicant in as complete detail as contained in Applicant's claims. As pointed out in Appellant's Appeal Brief, citing MPEP § 2131, a *prima facie* case of anticipation requires that the Examiner cite a single reference that expressly or inherently describes each and every element as set forth in the rejected claims and that the cited reference shows the identical invention in as complete detail as is contained in the rejected claims.

Applicant claims a root growth barrier comprising a layer of root-tip-trapping material bonded to a layer of a root impenetrable material. (Claims 1, 29, 46, 48). Applicant further claims a polymer sheet having a surface bonded to a porous fabric. (Claim 49).

Berlit provides no express or inherent description of any root-tip-trapping layers or any root-tip trapping material, which is a limitation claimed by Applicant. Berlit does not expressly or inherently describe any layers of the disclosed extruded pot that are a porous fabric, another limitation claimed by Applicant. A careful reading of Berlit does not reveal the use of the word

porous or any description, either express or implied, of a root tip being trapped in any type of material.

The Examiner argues, based upon Applicant's disclosure and not what is described within Berlit, that because Applicant disclosed that polypropylene may be made into a fiber, then woven into a fabric and then used as a root-tip-trapping material, that the extruded polypropylene pot disclosed by Berlit must also be made of a woven fiber and therefore, root-tip-trapping material. (Answer Brief, p. 3). However, Berlit does not expressly or inherently describe that the polypropylene pot disclosed therein is anything other than a smooth surfaced pot formed from an extrusion process.

To support his contention, the Examiner erroneously points to Berlit as disclosing a clay pot surface, which the Examiner asserts is not smooth, and thereby may be a root-tip-trapping material. (Answer Brief, p. 4). However, Berlit merely discloses that the *outer* layer of the pot, which is not in contact with the roots at all, may be *colored* brown so as to appear as a clay pot. (Berlit, p. 1, 108-114). Since Berlit discloses that the *outer* layer may be colored brown to resemble a clay pot, it is error for the Examiner to assert that Berlit discloses that the *inner* layer is *both* colored brown *and* porous, based only upon Berlit's disclosure that the *color* of the *outer* layer is similar to that of a clay pot.

The Examiner erroneously states "All Berlit states is that the layers are bonded together by laminate by co-extrusion (page 1, lines 28 & 100), just as the same claimed by Appellant in claim 15." (Answer Brief, p. 4). Appellant claims that "the root-tip-trapping material is bonded onto the root-impenetrable material by a method selected from gluing, laminating and combinations thereof." (Claim 15). Therefore, Appellant does not claim, as the Examiner asserts, that these layers are bonded together by co-extrusion.

Because Berlit fails to expressly or inherently describe each and every element as set forth in Appellant's rejected independent claims 1, 29, 46, 48 and 49 and further fails to show the identical invention in as complete detail as is contained in Appellant's independent claims 1, 29, 46, 48 and 49, a *prima facie* case of anticipation has not been presented by the Examiner. Therefore, Appellant respectfully requests this Board to find that Appellant's independent claims 1, 29, 46, 48 and 49 are patentable in light of the foregoing analysis and further that all claims depending therefrom are patentable.

(b). Whether claims 3, 5-7, 25, 26, 31, 32, 50, 51, 64 and 65 should stand rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. 2,073,576A of Berlit, *et al.*

1. Berlit does not teach or suggest all the limitations claimed by Appellant. Each of the claims that stand rejected under 35 U.S.C. 103(a) over Berlit are dependant claims that depend from independent claims 1, 29 or 49. Therefore, each of these rejected dependant claims are construed to include all the limitations of independent claims 1, 29 or 49 that are incorporated by reference into the dependent claims. 37 C.F.R. 1.75(c).

Much of the discussion in Appellant's Appeal Brief concerning Issue (b) addresses the claim limitations of claims 1, 29 and 49, which are incorporated by reference into the claims that stand rejected and are therefore relevant with respect to Issue (b). The Examiner did not address these limitations and presumably stands by the assertions regarding these claims as rejected under 35 U.S.C. 102(b), *supra*, as discussed under Issue (a). Appellant will not further discuss these limitations herein as they are fully briefed under Issue (b) in Appellant's Appeal Brief.

The Examiner admits that Berlit does not disclose the ranges of the properties that are contained within the claims that stand rejected under 103(a) over Berlit. (Answer Brief, p. 5). However, the Examiner fails to point out that Berlit also does not teach or suggest *any* of the *properties* for which Appellant claims a range. Berlit is silent and makes no suggestion or teaching, either explicitly or implicitly, regarding the property of porosity, *any* property that is associated with a fabric, or any other property that Appellant claimed as a limitation of the rejected claims now under consideration. The Examiner asserts that the claimed ranges are obvious because they would have been discovered through testing or experimentation and because there is no critical reason given for Appellant's claimed values. (Answer Brief, p. 5).

There is no overlapping of ranges between those ranges claimed by Appellant and those disclosed by Berlit because Berlit neither teaches nor suggests anything evenly remotely associated with the Appellant's claimed ranges or the properties associated with those ranges. Appellant claims ranges for properties that include, for example, root-tip-trapping elements per square inch, specific weight of a porous fabric per square yard and opening size of the pores in the porous fabric. (Claims 3, 5, 6, 7, 65, 50 and 51). Berlit is silent on these ranges as the Examiner admits, but is also silent as to any teaching or suggestion regarding these properties at all.

As taught by the MPEP, "In the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a *prima facie* case of obviousness exists." MPEP § 2144.05 I. "Similarly, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties." *Id.* The MPEP teaches that at least some suggestion or teaching

regarding the properties associated with the claimed range is required from at least one prior art reference before a *prima facie* case of obviousness may be established.

The Examiner has failed to cite any prior art reference that would indicate that Appellant's claimed limitations are obvious over any prior art that mentions the same properties over which Appellant claims a range. The Examiner dismisses a range as being unpatentable because there is no showing of criticality. Such is not the requirement of a *prima facie* case of obviousness. The Examiner must still cite a reference that at least discloses, teaches or suggests that such properties as root-tip-trapping elements per square inch, specific weight of a porous fabric per square yard and opening size of the pores in the porous fabric are at least relevant or even exist. Berlit is silent on these properties.

Because Berlit does not teach or suggest each and every limitation claimed by Appellant in the rejected claims, including those of the independent claims 1, 29 and 49 that are included by reference, a *prima facie* case of obviousness has not been presented by the Examiner. Therefore, Appellant respectfully requests this Board to find that claims 3, 5-7, 25, 26, 31, 32, 50, 51, 64 and 65 are patentable in light of the foregoing analysis.

2. The Examiner has fallen into the hindsight trap. The only reason presented by the Examiner to modify the cited references is: "Berlit clearly states that Berlit is interested in keeping the roots healthy, which is the same motivation as that of Appellant. Therefore, Berlit does address the same problem sought by Appellant, and that is to promote healthy root growth." (Answer Brief, p. 5). Appellant respectfully disagrees and asserts that the promotion of healthy root growth is not a problem to be solved, but a resulting general advantage. While attempting to

solve the same problem may be evidence of a motivation to modify a prior art reference, merely having the same advantage is not.

The case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirements for showing of the teaching, suggestion, or motivation to combine prior art references. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”). Evidence of a suggestion, teaching or motivation to combine references may flow from prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985).

In the case *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), the Court distinctly points out the requirement that particular findings are required as to the justification for modifying the teachings of a reference. The Court stated:

Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. The motivation, suggestion or teaching may come explicitly from a statement in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references . . . *The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art . . .* Whether the Board relies on an express or an implicit showing, it must provide particular findings related

thereto. Broad conclusory statements standing alone are not evidence.

Id. at 1370, emphasis provided.

Therefore, even though the Examiner has cited only Berlit as a single prior art reference to reject Appellant's claims, the Examiner must still provide a showing of a suggestion or motivation to *modify* the teachings of Berlit. The Examiner cannot find an explicit showing, so the Examiner has attempted to provide an implicit showing of the motivation or suggestion to modify Berlit. As the *Kotzab* Court requires, an implicit showing is what the teachings of Berlit, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.

The Examiner has failed to provide any evidence of a suggestion or motivation to modify Berlit. The nature of the problem to be solved by Berlit is not the same as the nature of the problem to be solved by Appellant. Berlit sought to solve the problem of thin-walled plant containers that allowed the passage of too much light and thus damaged the roots by exposing them to light. Berlit solved the problem by adding a pigment to the thin-walled containers to make the walls opaque and thereby protect the plant roots from exposure to light. Appellant sought to solve the problem of root circling and air-root pruning. (Specification, p.3-4). Appellant solved this problem by providing a planting container that includes a root-tip-trapping material bonded to a root impenetrable material.

Even using Appellant's specification as a blueprint, there is no suggestion or motivation to modify Berlit to show a root-tip-trapping material bonded to a root impenetrable material as claimed by Appellant. Using the teachings of Berlit, which is silent regarding any type of root-tip-trapping material or any reason to attempt to trap root tips, and the knowledge of one having

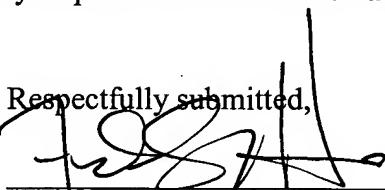
ordinary skill in the art, there is no suggestion or teaching within Berlit to bond a root-tip-trapping material to a root impenetrable material, to attempt to trap a root tip, or to solve the problem of root circling in a potted plant.

The Examiner asserts that both Berlit and Appellant have the same very general *advantage* – that of keeping the roots healthy – but that is not evidence of a suggestion or motivation for modifying Berlit to show that Appellant's claims are obvious. What is required is evidence of what the teachings of Berlit, the knowledge of one of ordinary skill in the art, and *the nature of the problem to be solved* as a whole would have suggested to those of ordinary skill in the art. The nature of the problem to be solved is not the same as a general advantage achieved, *i.e.*, healthy root growth. The Examiner has failed to provide evidence of a motivation or suggestion to modify Berlit and instead, has fallen into the hindsight trap, viewing the invention with the blueprint drawn by Appellant and not in the state of the art that existed at the time.

Therefore, because the Examiner has failed to provide evidence of the motivation to modify Berlit, a *prima facie* case of obviousness has not been presented. Therefore, Appellant respectfully requests this Board to find that claims 3, 5-7, 25, 26, 31, 32, 50, 51, 64 and 65 are patentable in light of the foregoing analysis

WHEREFORE, Appellant respectfully requests that the Board find that the claims 1-65 presented on appeal are patentable.

Respectfully submitted,



Frank J. Campigotto
Attorney for Appellant
Registration No. 48,130
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
713-939-9444